



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,400	01/15/2002	Dennis J. Michaelson	STES104	7667

21658 7590 05/26/2005

DYKAS, SHAVER & NIPPER, LLP
P.O. BOX 877
802 WEST BANNOCK STREET, SUITE 405
BOISE, ID 83701

EXAMINER

CHORBAJI, MONZER R

ART UNIT	PAPER NUMBER
----------	--------------

1744

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/050,400	Applicant(s) MICHAELSON ET AL.	
	Examiner MONZER R. CHORBAJI	Art Unit 1744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/13/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

W

DETAILED ACTION

This general action is in response to the application filing date of 01/15/2002

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In claim 1, lines 3 and 5, applicant recites the term "piano hinge", however, the disclosure makes no mention of such a feature. The same applies to claims 13 and 20.

Double Patenting

2. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

3. A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 2-17 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 2-17 of copending Application No. 10/050,370. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The scope of instant claim 2 is same as the scope of claim 2 in copending Application No. 10/050,370.

The scope of instant claim 3 is same as the scope of claim 3 in copending Application No. 10/050,370.

The scope of instant claim 4 is same as the scope of claim 4 in copending Application No. 10/050,370.

The scope of instant claim 5 is same as the scope of claim 5 in copending Application No. 10/050,370.

The scope of instant claim 6 is same as the scope of claim 6 in copending Application No. 10/050,370.

The scope of instant claim 7 is same as the scope of claim 7 in copending Application No. 10/050,370.

The scope of instant claim 8 is same as the scope of claim 8 in copending Application No. 10/050,370.

The scope of instant claim 9 is same as the scope of claim 9 in copending Application No. 10/050,370.

The scope of instant claim 10 is same as the scope of claim 10 in copending Application No. 10/050,370.

The scope of instant claim 11 is same as the scope of claim 11 in copending Application No. 10/050,370.

The scope of instant claim 12 is same as the scope of claim 12 in copending Application No. 10/050,370.

The scope of instant claim 13 is same as the scope of claim 13 in copending Application No. 10/050,370.

The scope of instant claim 14 is same as the scope of claim 14 in copending Application No. 10/050,370.

The scope of instant claim 15 is same as the scope of claim 15 in copending Application No. 10/050,370.

The scope of instant claim 16 is same as the scope of claim 16 in copending Application No. 10/050,370.

The scope of instant claim 17 is same as the scope of claim 17 in copending Application No. 10/050,370.

5. Claims 4-5 and 19-20 of application no. 10/050,400 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 14, 25 and 38 of prior U.S. Patent No. 6,368,565. This is a double patenting rejection.

The scopes of instant claims 4 and 19 of application no. 10/050,400 have the same the scope as of claims 1 and 14 of U.S. Patent No. 6,368,565.

The scopes of instant claims 5 and 20 of application no. 10/050,400 have the same the scope as of claims 25 and 38 of U.S. Patent No. 6,368,565.

6. Claims 19-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4-5 of copending Application No. 10/050,370. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The scope of instant claim 19 is same as the scope of claim 4 in copending Application No. 10/050,370.

The scope of instant claim 20 is same as the scope of claim 5 in copending Application No. 10/050,370.

7. Applicant is advised that should claims 4-5 be found allowable, claims 19-20 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

10. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claim 1 of Application No. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 and 37 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 1 is generic to claim 13 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 13 fully suggests claim 1 of application no. 10/050,400 and therefore, a patent to the genus (claim 1) would, necessarily, extend the rights of the species or subgenus (claim 13 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 1 is generic to claim 37 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 37 fully suggests claim 1 of application no. 10/050,400 and therefore, a patent to the genus (claim 1) would, necessarily, extend the rights of the species or subgenus (claim 37 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

12. Claims 2-3 and 6-17 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 2 is generic to claim 1 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 1 fully suggests claim 2 of application no. 10/050,400 and therefore, a patent to the genus (claim 2) would, necessarily, extend the rights of the species or subgenus (claim 1 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 3 is generic to claim 1 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 1 fully suggests claim 3 of application no. 10/050,400 and therefore, a patent to the genus (claim 3) would, necessarily, extend the rights of the

species or subgenus (claim 1 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 6 is generic to claim 2 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 2 fully suggests claim 6 of application no. 10/050,400 and therefore, a patent to the genus (claim 6) would, necessarily, extend the rights of the species or subgenus (claim 2 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 7 is generic to claim 3 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 3 fully suggests claim 7 of application no. 10/050,400 and therefore, a patent to the genus (claim 7) would, necessarily, extend the rights of the species or subgenus (claim 3 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 8 is generic to claim 4 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 4 fully suggests claim 8 of application no. 10/050,400 and therefore, a patent to the genus (claim 8) would, necessarily, extend the rights of the species or subgenus (claim 4 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 9 is generic to claim 5 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 5 fully suggests claim 9 of application no. 10/050,400 and therefore, a patent to the genus (claim 9) would, necessarily, extend the rights of the species or subgenus (claim 5 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 10 is generic to claim 6 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 6 fully suggests claim 10 of application no. 10/050,400 and therefore, a patent to the genus (claim 10) would, necessarily, extend the rights of the species or subgenus (claim 6 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 11 is generic to claim 7 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 7 fully suggests claim 11 of application no. 10/050,400 and therefore, a patent to the genus (claim 11) would, necessarily, extend the rights of the species or subgenus (claim 7 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 12 is generic to claim 8 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 8 fully suggests claim 12 of application no. 10/050,400 and therefore, a patent to the genus (claim 12) would, necessarily, extend the rights of the species or subgenus (claim 8 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 13 is generic to claim 9 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 9 fully suggests claim 13 of application no. 10/050,400 and therefore, a patent to the genus (claim 13) would, necessarily, extend the rights of the species or subgenus (claim 9 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 14 is generic to claim 10 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 10 fully suggests claim 14 of application no. 10/050,400 and

therefore, a patent to the genus (claim 14) would, necessarily, extend the rights of the species or subgenus (claim 10 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 15 is generic to claim 11 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 11 fully suggests claim 15 of application no. 10/050,400 and therefore, a patent to the genus (claim 15) would, necessarily, extend the rights of the species or subgenus (claim 11 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 16 is generic to claim 12 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 12 fully suggests claim 16 of application no. 10/050,400 and therefore, a patent to the genus (claim 16) would, necessarily, extend the rights of the species or subgenus (claim 12 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 17 is generic to claim 13 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 13 fully suggests claim 17 of application no. 10/050,400 and therefore, a patent to the genus (claim 17) would, necessarily, extend the rights of the species or subgenus (claim 13 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

13. Claims 2-3, 6-7 and 9-16 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14, 15-24 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 2 is generic to claim 14 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 14 fully suggests claim 2 of application no. 10/050,400 and therefore, a patent to the genus (claim 2) would, necessarily, extend the rights of the species or subgenus (claim 14 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 3 is generic to claim 14 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 14 fully suggests claim 3 of application no. 10/050,400 and therefore, a patent to the genus (claim 3) would, necessarily, extend the rights of the species or subgenus (claim 14 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 6 is generic to claim 15 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 15 fully suggests claim 6 of application no. 10/050,400 and therefore, a patent to the genus (claim 6) would, necessarily, extend the rights of the species or subgenus (claim 15 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 7 is generic to claim 16 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 16 fully suggests claim 7 of application no. 10/050,400 and therefore, a patent to the genus (claim 7) would, necessarily, extend the rights of the species or subgenus (claim 16 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 9 is generic to claim 17 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 17 fully suggests claim 9 of application no. 10/050,400 and

therefore, a patent to the genus (claim 9) would, necessarily, extend the rights of the species or subgenus (claim 17 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 10 is generic to claim 18 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 18 fully suggests claim 10 of application no. 10/050,400 and therefore, a patent to the genus (claim 10) would, necessarily, extend the rights of the species or subgenus (claim 18 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 11 is generic to claim 19 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 19 fully suggests claim 11 of application no. 10/050,400 and therefore, a patent to the genus (claim 11) would, necessarily, extend the rights of the species or subgenus (claim 19 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 12 is generic to claim 20 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 20 fully suggests claim 12 of application no. 10/050,400 and therefore, a patent to the genus (claim 12) would, necessarily, extend the rights of the species or subgenus (claim 20 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 13 is generic to claim 21 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 21 fully suggests claim 13 of application no. 10/050,400 and therefore, a patent to the genus (claim 13) would, necessarily, extend the rights of the

species or subgenus (claim 21 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 14 is generic to claim 22 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 22 fully suggests claim 14 of application no. 10/050,400 and therefore, a patent to the genus (claim 14) would, necessarily, extend the rights of the species or subgenus (claim 22 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 15 is generic to claim 23 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 23 fully suggests claim 15 of application no. 10/050,400 and therefore, a patent to the genus (claim 15) would, necessarily, extend the rights of the species or subgenus (claim 23 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 16 is generic to claim 24 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 24 fully suggests claim 16 of application no. 10/050,400 and therefore, a patent to the genus (claim 16) would, necessarily, extend the rights of the species or subgenus (claim 24 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

14. Claims 2-3 and 6-17 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 25-37 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 2 is generic to claim 25 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 25 fully suggests claim 2 of application no. 10/050,400 and therefore, a patent to the genus (claim 2) would, necessarily, extend the rights of the species or subgenus (claim 25 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 3 is generic to claim 25 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 25 fully suggests claim 3 of application no. 10/050,400 and therefore, a patent to the genus (claim 3) would, necessarily, extend the rights of the species or subgenus (claim 25 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 6 is generic to claim 26 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 26 fully suggests claim 6 of application no. 10/050,400 and therefore, a patent to the genus (claim 6) would, necessarily, extend the rights of the species or subgenus (claim 26 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 7 is generic to claim 27 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 27 fully suggests claim 7 of application no. 10/050,400 and therefore, a patent to the genus (claim 7) would, necessarily, extend the rights of the species or subgenus (claim 27 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 8 is generic to claim 28 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 28 fully suggests claim 8 of application no. 10/050,400 and

therefore, a patent to the genus (claim 8) would, necessarily, extends the rights of the species or subgenus (claim 28 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 9 is generic to claim 29 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 29 fully suggests claim 9 of application no. 10/050,400 and therefore, a patent to the genus (claim 9) would, necessarily, extends the rights of the species or subgenus (claim 29 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 10 is generic to claim 30 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 30 fully suggests claim 10 of application no. 10/050,400 and therefore, a patent to the genus (claim 10) would, necessarily, extends the rights of the species or subgenus (claim 30 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 11 is generic to claim 31 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 31 fully suggests claim 11 of application no. 10/050,400 and therefore, a patent to the genus (claim 11) would, necessarily, extends the rights of the species or subgenus (claim 31 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 12 is generic to claim 32 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 32 fully suggests claim 12 of application no. 10/050,400 and therefore, a patent to the genus (claim 12) would, necessarily, extends the rights of the

species or subgenus (claim 32 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 13 is generic to claim 33 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 33 fully suggests claim 13 of application no. 10/050,400 and therefore, a patent to the genus (claim 13) would, necessarily, extend the rights of the species or subgenus (claim 33 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 14 is generic to claim 34 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 34 fully suggests claim 14 of application no. 10/050,400 and therefore, a patent to the genus (claim 14) would, necessarily, extend the rights of the species or subgenus (claim 34 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 15 is generic to claim 35 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 35 fully suggests claim 15 of application no. 10/050,400 and therefore, a patent to the genus (claim 15) would, necessarily, extend the rights of the species or subgenus (claim 35 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 16 is generic to claim 36 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 36 fully suggests claim 16 of application no. 10/050,400 and therefore, a patent to the genus (claim 16) would, necessarily, extend the rights of the species or subgenus (claim 36 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 17 is generic to claim 37 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 37 fully suggests claim 17 of application no. 10/050,400 and therefore, a patent to the genus (claim 17) would, necessarily, extend the rights of the species or subgenus (claim 37 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

15. Claims 2-3, 6-7 and 9-16 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-48 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 2 is generic to claim 38 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 38 fully suggests claim 2 of application no. 10/050,400 and therefore, a patent to the genus (claim 2) would, necessarily, extend the rights of the species or subgenus (claim 38 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 3 is generic to claim 38 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 38 fully suggests claim 3 of application no. 10/050,400 and therefore, a patent to the genus (claim 3) would, necessarily, extend the rights of the species or subgenus (claim 38 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 6 is generic to claim 39 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 39 fully suggests claim 6 of application no. 10/050,400 and therefore, a patent to the genus (claim 6) would, necessarily, extend the rights of the

species or subgenus (claim 39 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 7 is generic to claim 40 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 40 fully suggests claim 7 of application no. 10/050,400 and therefore, a patent to the genus (claim 7) would, necessarily, extend the rights of the species or subgenus (claim 40 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 9 is generic to claim 41 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 41 fully suggests claim 9 of application no. 10/050,400 and therefore, a patent to the genus (claim 9) would, necessarily, extend the rights of the species or subgenus (claim 41 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 10 is generic to claim 42 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 42 fully suggests claim 10 of application no. 10/050,400 and therefore, a patent to the genus (claim 10) would, necessarily, extend the rights of the species or subgenus (claim 42 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 11 is generic to claim 43 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 43 fully suggests claim 11 of application no. 10/050,400 and therefore, a patent to the genus (claim 11) would, necessarily, extend the rights of the species or subgenus (claim 43 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 12 is generic to claim 44 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 44 fully suggests claim 12 of application no. 10/050,400 and therefore, a patent to the genus (claim 12) would, necessarily, extend the rights of the species or subgenus (claim 44 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 13 is generic to claim 45 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 45 fully suggests claim 13 of application no. 10/050,400 and therefore, a patent to the genus (claim 13) would, necessarily, extend the rights of the species or subgenus (claim 45 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 14 is generic to claim 46 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 46 fully suggests claim 14 of application no. 10/050,400 and therefore, a patent to the genus (claim 14) would, necessarily, extend the rights of the species or subgenus (claim 46 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 15 is generic to claim 47 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 47 fully suggests claim 15 of application no. 10/050,400 and therefore, a patent to the genus (claim 15) would, necessarily, extend the rights of the species or subgenus (claim 47 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim 16 is generic to claim 48 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 48 fully suggests claim 16 of application no. 10/050,400 and

therefore, a patent to the genus (claim 16) would, necessarily, extends the rights of the species or subgenus (claim 48 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

16. Claim 18 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 18 is generic to claim 1 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 1 fully suggests claim 18 of application no. 10/050,400 and therefore, a patent to the genus (claim 18) would, necessarily, extends the rights of the species or subgenus (claim 1 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

17. Claim 18 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 18 is generic to claim 14 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 14 fully suggests claim 18 of application no. 10/050,400 and therefore, a patent to the genus (claim 18) would, necessarily, extends the rights of the species or subgenus (claim 14 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

18. Claim 18 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 25 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 18 is generic to claim 25 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 25 fully suggests claim 18 of application no. 10/050,400 and therefore, a patent to the genus (claim 18) would, necessarily, extend the rights of the species or subgenus (claim 25 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

19. Claim 18 of application no. 10/050,400 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 38 of U.S. Patent No. 6,368,565. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following:

Claim 18 is generic to claim 38 (species) of U.S. Patent No. 6,368,565. U.S. Patent No. 6,368,565 claim 38 fully suggests claim 18 of application no. 10/050,400 and therefore, a patent to the genus (claim 18) would, necessarily, extend the rights of the species or subgenus (claim 38 of U.S. Patent No. 6,368,565) should the genus issue as a patent after the species or subgenus.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1744

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Spencer et al (U.S.P.N. 5,759,502).

With respect to claim 1, the Spencer reference discloses a tray for holding dental instruments in various sizes and shapes (col.2, lines 64-67) including the following: bottom plate (figure 1: 22), opposing side walls (figure 1: 18 and 20), front wall (figure 1: 16), back wall (figure 1: 14), plurality of interior divider walls (figure 1: 50 and 52), tray is made of a heat resistant sterilizable material (col.4, lines 52-53), shape of a tray that is open at the top (figure 1: 12 and 24) and having a plurality of compartments (figure 1: 50 and 52 creates two separated compartments) for holding segregated plurality of various sizes and shapes of dental instruments.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONZER R. CHORBAJI whose telephone number is (571) 272-1271. The examiner can normally be reached on M-F 6:30-3:00.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN KIM can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1744

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Monzer R. Chorbaji *MRC*
Patent Examiner
AU 1744
04/28/2005

John Kim
JOHN KIM
SUPERVISORY PATENT EXAMINER